

REMARKS

In the Office Action dated 14 May 2007, all claims pending in the above-captioned U.S. Patent Application were rejected. Applicant has carefully considered the Office Action and submits these amendments and remarks as a full and complete response. Applicant notes further that no new matter has been introduced, no new issues have been raised and assert that the application is in condition for allowance or better consideration for appeal.

Applicant has amended claims 28, 34 and 35 to better define the use of a shuttle card as an alternative enrollment methodology. Claim 30 is newly cancelled.

Applicant's invention is an aftermarket device which is added to a vehicle – car, truck, bus, boat, etc. – as an add-on. It is not attached during original manufacture (OEM). It can be removed and used on other vehicles at a later time.

At page 3 of the Office Action, the Office has stated a position on the preamble of a claim and cited *In re Hirao* ad *Kropa v. Robic* as authority. The preamble must be given patentable weight when the preamble is necessary to give life and meaning to a claim. In the automotive word, OEM and aftermarket are well defined and separately developed product lines. The OEM system is fully integrated into the electrical loom, exterior and interior architecture, warranties and dealer service training. A fingerprint-activated access and activation system installed as an assembly line item is specific for a manufacturer, can be disabled but not removed to a product of a different manufacturer (in most instances), being a permanent part of the vehicle as delivered to the dealer.

Aftermarket products, whenever possible, are designed to be used across manufacturer and model lines. They must be installed around the factory components

and come with their own wiring and separate attachment points. This distinctness is precisely the same as that to which *Kropa* teaching was directed.

The distinction noted *supra* is precisely why Applicant's hinged protective cover (claim 19, part a) is critical and distinct from Hsu and De Bono. The drawing (Fig 3) from Hsu upon which the Office relies is not a hinged protective cover. Instead, as stated at col. 4, lines 41 – 47, the sensor is on the underside of the door handle so that the print can be read and the handle pulled simultaneously, as the handle is cupped in the fingers.

De Bono is directed to a different issue, movement of the vehicle by unlocking a transmission. Access is not the issue; external conditions are not an issue. Styling may be.

Applicant notes that the necessary connection ("tying") the Hsu and De Bono claims so as to read upon Applicant's invention is "the examiner's position" stated at paragraph 3, page 2 of the most recent paper.

With regard to claim 17, and the Examiner's exegesis at the bottom of said page 2, two issues are raised. Firstly, it is implied that De Bono teaches sufficient back-up battery capacity to start the engine of a car. At col 9, lines 64 – 66, it is stated explicitly that the back-up battery 23 powers the biometric shifter lock control. This same terminology is followed in claims 14 and 15. With regard to the word ampere not appearing in the claims, it is noted that the capacity of a battery is measured in amp/hours or cold cranking amps.

Applicant has amended claims to define in greater detail the use of a shuttle card and reader.

The use of a shuttle card is based upon these steps. Note that the shuttle card is only appropriate when a number of people need access to multiple and changing vehicles such as police cars in large departments.

1. A user of a fleet is enrolled either at a vehicle or at a remote enrolling station.
2. The user's fingerprints are scanned and reduced to a mathematical template.
3. The mathematical templates are transferred to the shuttle card.
4. The shuttle card is also "keyed" to a fleet. It won't work with any other system.
5. The user approaches the vehicle that he wants access to. Using a physical means to enter the vehicle (either a key or the car is left unlocked on a lot), the user inserts the shuttle card into a reader on or under the dashboard of the vehicle.
6. The vehicle system authenticates the validity of the shuttle card, and then if authorized downloads the templates from the shuttle card into each sensor module on the vehicle.
7. The user removes the shuttle card and is now authorized to access the vehicle with his fingerprints.

In short, the shuttle card is a way of transferring enrollment from one vehicle to another without separate re-enrolling on each car.

Claim 19, and dependent claims 20 and 23 – 26 have been rejected over Hsu in view of De Bono and Radke. The Hsu system is unequivocally an OEM system, where TRW is especially active in fully integrated duo systems. As noted, this is a different field than aftermarket wherein TRW sells parts. Secondly, the drawings of Hsu do not disclose a protective cover over the external sensor and De Bono has an interior sensor only. This is particularly important with respect to claim 20, since an aftermarket external device is more exposed to climate hazards. Claims 23 through 26 address details of the device covered by claim 19 and related to the sealed unit and housing.

Claim 17, dependent upon 19, is directed to the battery size and utility. The non-applicability of Hsu and De Bono has been discussed. New references to Radke and Foster, Jr. have been cited as well. Radke teaches batteries as a primary source of power for a fingerprint reader, unrelated to any automotive use.

Foster discloses a battery backup for a fixed location secure entry system. The backup may be of unrestricted size and serves only to operate the security service – circuit, LED microphone and short cycle solenoid locks. The backup power supply does not partially recharge a larger battery and exists only to maintain service when a fixed, usually AC, system is inoperative. The power requirements are so different as to be non-analogous and Foster is not properly applied in this context.

Claims 28 – 29 are directed to the shuttle card system for alternative fingerprint enrollment. A new reference Carta International WO 02/091311 has been cited. The primary difference between Applicant's invention and the Carta reference is that the Applicant's shuttle card is a method for one-time enrollment of a fingerprint into the system on each vehicle. The Carta system requires the presentation of the card for each entry and codes or biometrics are secondary to the initial presentation of the card. This is no different than a key-based print reader. If the key/card is lost, the system is secure but access is impossible without damage to the vehicle and the ultimate result is no better than the old cut key system.

Claims 34 and 36 – 38 have been rejected under the combination of Hsu et al., De Bono, Radke, with new reference Bonder added. Bonder uses the key-based system described above. The key remains critical to the system. With Applicant's shuttle card, the card enrolls and empowers the fingerprint indefinitely.

Claim 35, since amended, had been rejected under the chain of Hsu, De Bono, Radke, Bonder and Dutu. Firstly, the amended claim makes clear that the system does not enable a shuttle card for all cars. Secondly, this daisy chain of references is not what the Supreme Court intended when defining "obviousness" and "obvious to try" in KSR. A reasonable limit remains on the number of references applied to one claim.

In view of these amendments and remarks, Applicant submits that the application is in condition for allowance and requests reconsideration and passage to issue.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "J. Herbert O'Toole", written over the typed name.

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Date: August 14, 2007